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## **I. STATUS OF CLAIMS**

Claims 1-48 are pending.

Claims 1-9, 13, 15, 18 and 22-48 stand rejected under 35 U.S.C. § 102(b) as being unpatentable over Wallace et al (U.S. Patent No. 3,860,796) (hereinafter "Wallace"). See *Office Action*, p. 2 (30 November 2009).

Claims 10-12 and 19-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wallace in view of Dunlap et al (U.S. Printed Patent Application No. 2005/0068182) (hereinafter "Dunlap"). See *Office Action*, p. 4 (30 November 2009).

Claims 14 and 16-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wallace in view of McEwan (U.S. Printed Patent Application No. 2005/0137584) (hereinafter "McEwan"). See *Office Action*, p. 5 (30 November 2009).

## **II. ISSUES TO BE REVIEWED**

The issues in this response relate to whether the Patent Office has established a *prima facie* case of the unpatentability of Applicant's Claims 1-48 under 35 U.S.C. 102/103 based on objective evidence. For reasons set forth elsewhere herein, Applicant respectfully asserts that the Patent Office has not established a *prima facie* case of the unpatentability of any pending claim. Accordingly, Applicant respectfully requests that The Patent Office hold all pending Claims 1-48 allowable for at least the reasons described herein, and issue a Notice of Allowance on same.

## **III. ARGUMENT: PATENT OFFICE HAS NOT ESTABLISHED *PRIMA FACIE* CASE OF UNPATENTABILITY IN VIEW OF CITED ART OF RECORD**

The Patent Office has stated "Claims 1-13 and 18-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Hinks et al (US 4,625,101)"; and "Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinks et al in

view of Hazelrigg et al (US 5,481,102).” See *The Patent Office’s Office Action*, pp. 2 and 4 (1 April 2009).

In response, Applicant respectfully asserts herein that, under the MPEP and legal standards for patentability, the Patent Office has not established a *prima facie* case of the unpatentability of Applicant’s claims at issue. Specifically, Applicant respectfully shows below that: 1) significant distinctions exist between the text of Applicant’s claims and the Patent Office-cited references; and 2) the Patent Office’s interpretation of the cited references and/or Applicant’s claims is not supported by objective evidence sufficient to reconcile the significant distinctions between the Patent Office-cited references and, hence, fails to establish a *prima facie* case of unpatentability. Accordingly, Applicant respectfully requests that the Patent Office withdraw his rejections and hold all claims to be allowable over the art of record.

#### **A. MPEP Standards for Patentability<sup>1</sup>**

The MPEP states as follows: “the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant. . . . If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.” *MPEP* § 2107 (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)); *In Re Glaug* 283 F.3d 1335, 62 USPQ2d 1151 (Fed. Cir. 2002) (“During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the applicant is entitled to the patent.”). Accordingly, unless and until an examiner presents evidence establishing *prima facie* unpatentability, an applicant is entitled to a patent on all claims presented for examination.

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<sup>1</sup> Applicant is aware that Examiner is familiar with the MPEP standards. Applicant is merely setting forth the MPEP standards to serve as a framework for Applicant’s arguments following and to ensure a complete written record is established. Should Examiner disagree with Applicant’s characterization of the MPEP standards, Applicant respectfully requests correction.

## 1. MPEP Standards for Determining Anticipation

An examiner bears the initial burden of factually supporting any *prima facie* conclusion of anticipation. *Ex Parte Skinner*, 2 U.S.P.Q.2d 1788, 1788-89 (B.P.A.I. 1986); *In Re King*, 801 F.2d 1324, 231 U.S.P.Q. (BNA) 136 (Fed. Cir. 1986); *MPEP* § 2107 (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992) (“[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability....”). Failure of an examiner to meet this burden entitles an applicant to a patent. *Id.* (“[i]f examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent”).

The MPEP indicates that in order for an examiner to establish a *prima facie* case of anticipation of an applicant's claim, the examiner must first interpret the claim,<sup>2</sup> and thereafter show that the cited prior art discloses the same elements, in the same arrangement, as the elements of the claim which the examiner asserts is anticipated. More specifically, the MPEP states that “[a] claim is anticipated *only if each and every element as set forth in the claim is found*, either expressly or inherently described, in a single prior art reference. . . . The identical invention must be shown *in as complete detail* as is contained in the . . . claim. . . . The elements must be *arranged as required by the claim* . . .” *MPEP* § 2131 (emphasis added). Consequently, under the guidelines of the MPEP set forth above, if there is *any* substantial difference between the prior art cited by an examiner and an applicant's claim which the examiner asserts is rendered anticipated by the prior art, the prior art does NOT establish a *prima facie* case of anticipation and, barring other rejections, the applicant is entitled to a patent on such claim.

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<sup>2</sup> With respect to interpreting a claim at issue, the MPEP directs that, during examination -- as opposed to subsequent to issue -- such claim be interpreted as broadly as the claim terms would reasonably allow, in light of the specification, when read by one skilled in the art with which the claimed invention is most closely connected. *MPEP* § 2111.

## 2. MPEP Standards for Determining Obviousness

"[T]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness."<sup>3</sup> *MPEP* § 2142. The MPEP indicates that in order for an examiner to establish a *prima facie* case that an invention, as defined by a claim at issue, is obvious, the examiner must (1) interpret the claim at issue; (2) define one or more prior art reference components relevant to the claim at issue; (3) ascertain the differences between the one or more prior art reference components and the elements of the claim at issue; and (4) adduce objective evidence which establishes, under a preponderance of the evidence standard, a teaching to modify the teachings of the prior art reference components such that the prior art reference components can be used to construct a device substantially equivalent to the claim at issue. This last step generally encompasses two sub-steps: (1) adducement of objective evidence teaching how to modify the prior art components to achieve the individual elements of the claim at issue; and (2) adducement of objective evidence teaching how to combine the modified individual components such that the claim at issue, as a whole, is achieved. *MPEP* § 2141; *MPEP* § 2143. Each of these forgoing elements is further defined within the MPEP. *Id.*

This requirement has been explained recently by the Supreme Court in *KSR v. Teleflex*, 550 U.S. \_\_\_\_; 127 S. Ct. 1727 (2007) which noted that such a rejection requires "some articulated reasoning ... to support the legal conclusion of obviousness." As stated by the Court, obviousness can be established where "there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, **this analysis should be made explicit.**" (*emphasis added*) See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory

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<sup>3</sup> An invention, as embodied in the claims, is rendered obvious if an examiner concludes that although the claimed invention is not identically disclosed or described in a reference, the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *MPEP* § 2141 (citing 35 U.S.C. § 103).

statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’).” *KSR v. Teleflex*, 550 U.S. \_\_\_\_; 127 S. Ct. 1727 at 1741.

As further described by the Court “[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *KSR v. Teleflex*, 550 U.S. \_\_\_\_; 127 S. Ct. 1727 at 1741.

#### **a) Interpreting a Claim at Issue**

With respect to interpreting a claim at issue, the MPEP directs that, during examination – as opposed to subsequent to issue – such claim be interpreted as broadly as the claim terms would reasonably allow when read by one skilled in the art with which the claimed invention is most closely connected. In practice, this is achieved by giving each of the terms in the claim the “plain meaning” of the terms as such would be understood by those having ordinary skill in the art, and if portions of the claim have no “plain meaning” within the art, or are ambiguous as used in a claim, then the examiner is to consult the specification for clarification. *MPEP* § 2111.

#### **b) Definition of One or More Prior Art Reference Components Relevant to the Claim at Issue**

Once the claim at issue has been properly interpreted, the next step is the definition of one or more prior art reference components (e.g., electrical, mechanical, or other components set forth in a prior art reference) relevant to the



properly interpreted claim at issue. With respect to the definition of one or more prior art reference components relevant to the claim at issue, the MPEP defines three proper sources of such prior art reference components, with the further requirement that each such source must have been extant at the time of invention to be considered relevant. These three sources are as follows: patents as defined by 35 U.S.C. § 102, printed publications as defined by 35 U.S.C. § 102 and information (e.g., scientific principles) deemed to be “well known in the art”<sup>4</sup> as defined under 35 U.S.C. § 102. *MPEP* § 2141; *MPEP* § 2144.

**c) Ascertainment of Differences between Prior Art Reference Components and Claim at Issue; Teaching to Modify and/or Combine Prior Art Reference Components to Remedy Those Differences in Order to Achieve Recitations of Claim at Issue**

With one or more prior art components so defined and drawn from the proper prior art sources, the differences between the one or more prior art reference components and the elements of the claim at issue are to be ascertained. Thereafter, in order to establish a case of *prima facie* obviousness, an examiner must set forth a rationale, supported by objective evidence<sup>5</sup> sufficient to demonstrate under a preponderance of the evidence standard, that in the prior art extant at the time of invention there was a teaching to modify and/or combine the

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<sup>4</sup> The fact that information deemed to be “well known in the art” can serve as a proper source of prior art reference components seems to open the door to subjectivity, but such is not the case. As a remedy to this potential problem, *MPEP* § 2144.03 states that if an examiner asserts that his position is derived from and/or is supported by a teaching or suggestion that is alleged to have been “well known in the art,” and that if an applicant traverses such an assertion (that something was “well known within the art”), the examiner must cite a reference in support of his or her position. The same *MPEP* section also states that when a rejection is based on facts within the personal knowledge of an examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons. *Id.* Thus, all sources of prior art reference components must be objectively verifiable.

<sup>5</sup> The proper sources of the objective evidence supporting the rationale are the defined proper sources of prior art reference components, discussed above, with the addition of factually similar legal precedent. *MPEP* § 2144.

one or more prior art reference components to construct a device practicably equivalent to the claim at issue.

The preferable evidence relied upon is an express teaching to modify/combine within the properly defined objectively verifiable sources of prior art. In the absence of such express teaching, an examiner may attempt to establish a rationale to support a finding of such teaching reasoned from, or based upon, express teachings taken from the defined proper sources of such evidence (*i.e.*, properly defined objectively verifiable sources of prior art). *MPEP* § 2144; *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999).

The MPEP recognizes the pitfalls associated with the tendency to subconsciously use impermissible "hindsight" when an examiner attempts to establish such a rationale. The MPEP has set forth at least two rules to ensure against the likelihood of such impermissible use of hindsight. The first rule is that:

under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information,<sup>6</sup> the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of an Applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search, and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon an Applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

*MPEP* § 2142 (emphasis added). Thus, if the only objective evidence of such teaching to modify and/or combine prior art reference components is an applicant's disclosure, no evidence of such teaching exists.<sup>7</sup>

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<sup>6</sup> "Factual information" is information actually existing or occurring, as distinguished from mere supposition or opinion. *Black's Law Dictionary* 532 (5th ed. 1979).

<sup>7</sup> An applicant may argue that an examiner's conclusion of obviousness is based on improper hindsight reasoning. However, "[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge

The second rule is that if an examiner attempts to rely on some advantage or expected beneficial result that would have been produced by a modification and/or combination of the prior art reference components as evidence to support a rationale to establish such teachings to modify and/or combine prior art reference components, the MPEP requires that such advantage or expected beneficial result be objectively verifiable teachings present in the acceptable sources of prior art (or drawn from a convincing line of reasoning based on objectively verifiable established scientific principles or teachings). MPEP § 2144. Thus, as a guide to avoid the use of impermissible hindsight, these rules from the MPEP make clear that absent some objective evidence, sufficient to persuade under a preponderance of the evidence standard, no teaching of such modification and/or combination exists.<sup>8</sup>

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which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." MPEP § 2145(X)(A) (emphasis added).

<sup>8</sup> *In Re Sang Su Lee* 277 F.3d 1338 (Fed. Cir. 2002) ("When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.") See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the *Graham* factors). "The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984)). The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art

## B. Claim 1

The Patent Office has stated: "Claim[] 1...[is] rejected under 35 U.S.C. 102(b) as being anticipated by Wallace et al. (US 3,860,796)." See *Office Action*, p. 2 (30 November 2009).

Claim 1 recites, in part, as follows: "An item comprising: a) an outer part including at least one outer material that is substantially opaque to visible light; and b) an identifier including at least one three-dimensional configuration corresponding to the identifier, the at least one three-dimensional configuration being embedded within the at least one outer material and including at least one of (1) a substantially empty cavity in the at least one outer material, or (2) at least one identifying material filling at least part of a cavity in the at least one outer material and wherein the at least one outer material in which the at least one identifying material fills at least part of the cavity is substantially opaque to visible light."<sup>9</sup>

Applicant respectfully asserts herein that, under the MPEP and legal standards for patentability, the Patent Office has failed to establish a *prima facie* case of the unpatentability of Applicant's claims at issue. Specifically, Applicant respectfully shows below that: 1) the technical references cited by the Patent Office do not recite the text of Applicant's claims; and 2) has the Patent Office failed to provide an interpretation of those technical references supported by objective evidence which reconciles those differences. Accordingly, Applicant respectfully requests that the Patent Office withdraw its rejections and hold Claim 1 to be allowable over the Patent Office-cited references.

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would have been motivated to select the references and to combine them to render the claimed invention obvious.")).

<sup>9</sup> The lettering of the clauses herein is merely for sake of clarity of argument and should not be taken to imply any particular ordering of the clauses.

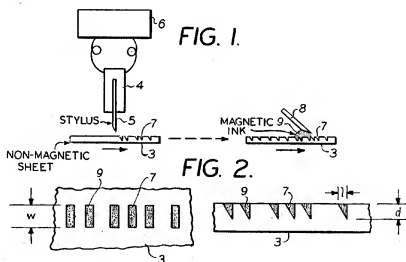
**1. Significant Distinctions Exist Between the Wallace Reference Cited by the Patent Office and Applicant's Claim 1; The Patent Office has Failed to Provide Objective Evidence Supporting Its Interpretation of Claim 1 and/or Wallace**

With respect to Claim 1, the Patent Office has stated:

Wallace teaches an item comprising: an outer part (member 3) including at least one outer material (plastic 20 mils thick) (col. 2, lines 63-64); and an identifier including at least one three-dimensional configuration corresponding to the identifier, the at least one three-dimensional configuration being embedded within the at least one outer material and including at least one of (1) a substantially empty cavity in the at least one outer material, or (2) at least one identifying material (magnetic ink paste 9) filling at least part of a cavity in the at least one outer material and wherein the at least one outer material in which the at least one identifying material fills at least part of the cavity is substantially opaque to visible light;

See *Office Action*, pp. 2-3. (Emphasis added).

Applicant respectfully points out that Wallace does not actually recite as suggested by the Patent Office. Rather, the portions of Wallace cited by the Patent Office recite as follows:

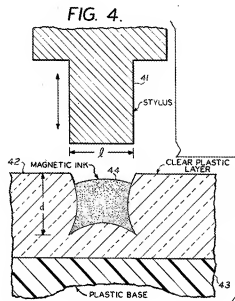


See Wallace, FIGs. 1 and 2

The stylus strikes the surface of the record member 3, leaving a line of indentations 7 spaced in an alpha-numeric code form. The

presence of an indentation, for example, may represent the binary "1" signal and the absence, the binary "0" signal. The record member can usually be passed under the recording head at a rate of 1 to 50 inches per second. After being indented, the record member next has a magnetic ink paste 9 squeezed into the indentations, as by a blade 8. The surface of the card may then be wiped, if necessary, and the ink is allowed to cure.

See Wallace, col. 2, lines 41-53 (Emphasis added).



See Wallace, FIG. 4

A plastic card comprised of a plastic base layer 43 with a clear plastic top coating 42 is overcoated with a layer of a magnetic ink or paste (not shown) in the area to be indented, and the ink is partially pre-dried, if desired, to some extent. A blunt end stylus 41 is then used to indent the card in the manner previously described and force the ink 44 into the indentation.

See Wallace, col. 3, lines 41-47

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference...The identical invention must be shown in as complete detail as is contained in the...claim...The elements must be arranged as required by the claim..." MPEP § 2131 (emphasis added).

Applicant has reviewed the Patent Office-cited portions of Wallace (i.e. those portions which must support a case of unpatentability on their face) and, as can be seen from the foregoing, the Patent Office failed to provide any evidence to support its allegations that Wallace expressly teaches or suggests the all the claim features of clause [b] of Claim 1.

As noted, clause [b] of Claim 1 recites: “[b] an identifier including at least one three-dimensional configuration corresponding to the identifier, the at least one three-dimensional configuration being embedded within the at least one outer material.” (Emphasis added)

In contrast, Wallace merely recites: “The stylus strikes the surface of the record member 3, leaving a line of indentations...and magnetic ink paste 9 [is] squeezed into the indentations” or that “[a] blunt end stylus...is then used to indent the card in the manner previously described and force the ink...into the indentation.”

As can be seen from the directly quoted portions of Wallace and Applicant's claims, significant distinctions exist between the express recitations of Wallace and the Applicant's claims (e.g. Wallace's failure to expressly recite a “three-dimensional configuration being embedded within the at least one outer material.”)

As such, the burden rests on the Patent Office to provide an interpretation of Wallace and Claim 1 supported by objective evidence that “bridges the gap” between the actual recitations of Wallace and the actual recitations of Applicant's claims. In its attempt to account for those significant distinctions it appears to Applicant that the Patent Office has mapped the recitations of a “three-dimensional configuration being embedded within the at least one outer material” of Claim 1 onto “a line of indentations.”

As can be seen from the directly quoted portions of the Patent Office rejection of Claim 1, the Patent Office has failed to provide objective evidence that demonstrates that “a line of indentations” of Wallace may be interpreted to teach or suggest a “three-dimensional configuration being embedded within the at least one outer material” as in Claim 1. Particularly, Applicant respectfully submits that the Patent Office has not explained how it reaches such mappings under the broadest

reasonable interpretation framework<sup>10</sup> as is the Patent Office's burden (e.g., such as by examples drawn from Applicant's claims or detailed description). Applicant points out that although Claim 1 has been quoted in the present rejection, several claim terms have not been addressed<sup>11</sup> in the Patent Office's analysis (e.g. at least the recitations "embedded within").

What a reference "teaches" is a question of fact. Conclusory statements that a reference "teaches" something beyond its bare recitations/direct disclosures do not constitute ANY evidence of such "teachings" unless they are supported by objective evidence. See *In re McNeil-PPC*, 2008-1546 (Fed. Cir. July 31, 2009); *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

Thus, when a party to a matter asserts that a reference "teaches" something beyond its bare recitations/direct disclosure, and that factual assertion is challenged by an opposite party, the law requires that the asserting party provide objective evidentiary support to "close the gap" between what the reference actually recites and what the asserting party alleges the reference teaches. In the absence of such evidence, there should be no finding of fact in favor of the asserted teaching.

Because the Patent Office failed to establish that Wallace expressly teaches or suggests the recitations of Claim 1 and the Patent Office has failed to provide an interpretation of Wallace supported by objective evidence which properly maps these recitations to the recitations of Wallace, under MPEP guidelines the Patent Office has not established a *prima facie* case of the unpatentability of Claim 1. For these reasons, Applicant respectfully asks the USPTO to hold Claim 1 allowable and to issue a Notice of Allowability of same.

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<sup>10</sup> During patent examination, the Patent Office determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004).

<sup>11</sup> "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).



**2. The Patent Office's Interpretation of Wallace Appears to be Based on Inadvertent Impermissible Hindsight, Personal Knowledge, or Official Notice**

Given that Applicant has shown, above, what Wallace actually recites, the question thus naturally arises as to how the Patent Office saw Wallace as "teaching" something related to Claim 1. Applicant respectfully points out that the Applicant's Application is the only objectively verifiable Patent Office-cited document of record that shows or suggests what the Patent Office purports the references to teach. From this and the express recitations of Wallace as set forth above, it follows that the Patent Office may be interpreting Wallace through the lens of Applicant's application, which is impermissible hindsight use. If such is the case, at present, the Patent Office's assertions regarding Wallace are untenable.

Further, as the Patent Office has provided no objectively verifiable evidence, nor argument based on objectively verifiable evidence, in support of the Patent Office interpretation regarding what the technical material cited by the Patent Office "teaches," Applicant infers that the Patent Office may be relying on "personal knowledge" and/or is taking "official notice" of one or more factors to reach the factual conclusion of what the cited technical material "teaches" but has failed to expressly acknowledge as such in the written record.

In view of the foregoing, if the Patent Office desires to maintain the rejection, in the next communication, Applicant respectfully requests that the Patent Office provide an affidavit or declaration setting forth objectively verifiable evidence in support of the Patent Office's currently unsupported assertions regarding what the cited technical material "teaches" and/or should be interpreted to "teach." See, e.g., MPEP § 2144.03(C), *If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Patent Office Must Support the Finding with Adequate Evidence*, and 37 C.F.R. 1.104(d)(2).

Absent an affidavit setting forth such objectively verifiable evidence supporting the Patent Office's interpretation of Wallace, under MPEP standards, the Patent Office has not established a *prima facie* case that the Patent Office-cited

references of record render Claim 1 *prima facie* unpatentable. Applicant respectfully asks the Patent Office to hold Claim 1 allowable and to issue a Notice of Allowance of same.

**C. Claims 2-12 Patentable for at Least Reasons of Dependency from Claim 1**

Claims 2-12 depend either directly or indirectly from Claim 1. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." See 35 U.S.C. § 112 paragraph 4. Consequently, Claims 2-12 are patentable for at least the reasons why Claim 1 is patentable. Accordingly, Applicant respectfully requests that The Patent Office hold Claims 2-12 patentable for at least the foregoing reasons, and issue a Notice of Allowability on same.

**D. Claim 2 Independently Patentable**

The Patent Office has stated: "Claim[] 2...[is] rejected under 35 U.S.C. 102(b) as being anticipated by over Wallace et al. (US 3,860,796)." See *Office Action*, p. 2 (30 November 2009).

Claim 2 recites, in part, as follows: "the at least one outer material is transmissive to RF radiation." (Emphasis added).

Applicant respectfully asserts herein that, under the MPEP and legal standards for patentability, the Patent Office has failed to establish a *prima facie* case of the unpatentability of Applicant's claims at issue. Specifically, Applicant respectfully shows below that: 1) the technical references cited by the Patent Office do not recite the text of Applicant's claims; and 2) has the Patent Office failed to provide an interpretation of those technical references supported by objective evidence which reconciles those differences. Accordingly, Applicant respectfully requests that the Patent Office withdraw its rejections and hold Claim 2 to be allowable over the Patent Office-cited references.

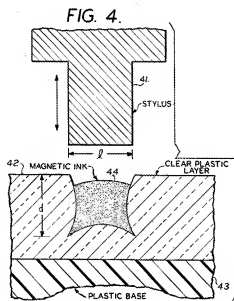
1. **Significant Distinctions Exist Between the Wallace Reference Cited by the Patent Office and Applicant's Claim 2; The Patent Office has Failed to Provide Objective Evidence Supporting Its Interpretation of Claim 2 and/or Wallace**

With respect to Claim 2, the Patent Office has stated:

Wallace teaches...the item wherein the at least one outer material is transmissive to RF radiation (see figure 4);

See *Office Action*, p. 3. (Emphasis added).

Applicant respectfully points out that Wallace does not actually recite as suggested by the Patent Office. Rather, the portions of Wallace cited by the Patent Office recite as follows:



See Wallace, FIG. 4

A plastic card comprised of a plastic base layer 43 with a clear plastic top coating 42 is overcoated with a layer of a magnetic ink or paste (not shown) in the area to be indented, and the ink is partially pre-dried, if desired, to some extent. A blunt end stylus 41 is then used to indent the card in the manner previously described and force the ink 44 into the indentation.

See Wallace, col. 3, lines 41-47 (Emphasis added).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference...The identical invention must be shown in as complete detail as is contained in the...claim...The elements must be arranged as required by the claim..." MPEP § 2131 (emphasis added).

Applicant has reviewed the Patent Office-cited portions of Wallace (i.e. those portions which must support a case of unpatentability on their face) and, as can be seen from the foregoing, the Patent Office failed to provide any evidence to support its allegations that Wallace expressly teaches or suggests the all the claim features of Claim 2.

As noted, of Claim 2 recites: "the at least one outer material is transmissive to RF radiation." (Emphasis added)

In contrast, Wallace merely recites: "A plastic card comprised of a plastic base layer...with a clear plastic top coating...."

As can be seen from the directly quoted portions of Wallace and Applicant's claims, significant distinctions exist between the express recitations of Wallace and the Applicant's claims (e.g. Wallace's failure to expressly recite that the "outer material is transmissive to RF radiation.")

As such, the burden rests on the Patent Office to provide an interpretation of Wallace and Claim 2 supported by objective evidence that "bridges the gap" between the actual recitations of Wallace and the actual recitations of Applicant's claims. In its attempt to account for those significant distinctions it appears to Applicant that the Patent Office has mapped the recitations of a outer material is transmissive to RF radiation" of Claim 2 onto "A plastic card comprised of a plastic base layer...with a clear plastic top coating."

As can be seen from the directly quoted portions of the Patent Office rejection of Claim 2, the Patent Office has failed to provide objective evidence that demonstrates that the "plastic card comprised of a plastic base layer...with a clear plastic top coating" of Wallace may be interpreted to teach or suggest a "material that is transmissive to RF radiation" as in Claim 2. Particularly, Applicant respectfully submits that the Patent Office has not explained how it reaches such

mappings under the broadest reasonable interpretation framework<sup>12</sup> as is the Patent Office's burden (e.g., such as by examples drawn from Applicant's claims or detailed description). Applicant points out that although Claim 2 has been quoted in the present rejection, several claim terms have not been addressed<sup>13</sup> in the Patent Office's analysis (e.g. at least the recitations "transmissive to RF radiation").

What a reference "teaches" is a question of fact. Conclusory statements that a reference "teaches" something beyond its bare recitations/direct disclosures do not constitute ANY evidence of such "teachings" unless they are supported by objective evidence. See *In re McNeil-PPC*, 2008-1546 (Fed. Cir. July 31, 2009); *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

Thus, when a party to a matter asserts that a reference "teaches" something beyond its bare recitations/direct disclosure, and that factual assertion is challenged by an opposite party, the law requires that the asserting party provide objective evidentiary support to "close the gap" between what the reference actually recites and what the asserting party alleges the reference teaches. In the absence of such evidence, there should be no finding of fact in favor of the asserted teaching.

Because the Patent Office failed to establish that Wallace expressly teaches or suggests the recitations of Claim 2 and the Patent Office has failed to provide an interpretation of Wallace supported by objective evidence which properly maps these recitations to the recitations of Wallace, under MPEP guidelines the Patent Office has not established a *prima facie* case of the unpatentability of Claim 2. For these reasons, Applicant respectfully asks the USPTO to hold Claim 2 allowable and to issue a Notice of Allowability of same.

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<sup>12</sup> During patent examination, the Patent Office determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004).

<sup>13</sup> "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

### **E. Claim 3 Independently Patentable**

The Patent Office has stated: "Claims 1-9, 13, 15, 18 and 22-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Wallace et al. (US 3,860,796)." See *Office Action*, p. 2 (30 November 2009).

Claim 3 recites, in part: "the item is produced by rapid prototyping."

Applicant respectfully asserts herein that, under the MPEP and legal standards for patentability, the Patent Office has failed to establish a *prima facie* case of the unpatentability of Applicant's claims at issue. Specifically, Applicant respectfully shows below that: 1) the technical references cited by the Patent Office do not recite the text of Applicant's claims; and 2) has the Patent Office failed to provide an interpretation of those technical references supported by objective evidence which reconciles those differences. Accordingly, Applicant respectfully requests that the Patent Office withdraw its rejections and hold Claim 3 to be allowable over the Patent Office-cited references.

#### **1. Significant Distinctions Exist Between the Wallace Reference Cited by the Patent Office and Applicant's Claim 3; The Patent Office has Failed to Provide Objective Evidence Supporting Its Interpretation of Claim 3 and/or Wallace**

With respect to Claim 3, the Patent Office has stated:

Wallace teaches...the item is produced by rapid prototyping;

See *Office Action*, p. 3. (Emphasis added).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference...The identical invention must be shown in as complete detail as is contained in the...claim...The elements must be arranged as required by the claim..." MPEP § 2131 (emphasis added).

As can be seen from the directly quoted portions of the Patent Office rejection of Claim 3, the Patent Office has failed to provide any objective evidence that demonstrates that the Wallace may be interpreted to teach or suggest "the item

is produced by rapid prototyping" as in Claim 3. While Claim 3 has been quoted in the present rejection, several claim terms have not been addressed<sup>14</sup> in the Patent Office's analysis (e.g. at least the recitations "embedded within").

What a reference "teaches" is a question of fact. Conclusory statements that a reference "teaches" something beyond its bare recitations/direct disclosures do not constitute ANY evidence of such "teachings" unless they are supported by objective evidence. See *In re McNeil-PPC*, 2008-1546 (Fed. Cir. July 31, 2009); *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

Thus, when a party to a matter asserts that a reference "teaches" something beyond its bare recitations/direct disclosure, and that factual assertion is challenged by an opposite party, the law requires that the asserting party provide objective evidentiary support to "close the gap" between what the reference actually recites and what the asserting party alleges the reference teaches. In the absence of such evidence, there should be no finding of fact in favor of the asserted teaching.

Because the Patent Office failed to establish that Wallace expressly teaches or suggests the recitations of Claim 3 and the Patent Office has failed to provide an interpretation of Wallace supported by objective evidence which properly maps these recitations to the recitations of Wallace, under MPEP guidelines the Patent Office has not established a *prima facie* case of the unpatentability of Claim 3. For these reasons, Applicant respectfully asks the USPTO to hold Claim 3 allowable and to issue a Notice of Allowability of same.

#### **F. Claim 6 Independently Patentable**

The Patent Office has stated: "Claims 1-9, 13, 15, 18 and 22-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Wallace et al. (US 3,860,796)." See *Office Action*, p. 2 (30 November 2009).

Claim 6 recites as follows: "the at least one three-dimensional configuration is completely enclosed by the at least one outer material." (Emphasis added).

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<sup>14</sup> "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference...The identical invention must be shown in as complete detail as is contained in the...claim...The elements must be arranged as required by the claim..." MPEP § 2131 (emphasis added).

With respect to Claim 6, the Patent Office has failed to provide any objective evidence that demonstrates that the Wallace may be interpreted to teach or suggest that "the...three-dimensional configuration is completely enclosed by the at least one outer material" as in Claim 6. Specifically, following Applicant's reading of the Office Action, it does not appear that the Patent Office has even addressed Claim 6 in the Office Action outside of its blanket rejection of "Claims 1-9, 13, 15, 18 and 22-48."

Because the Patent Office failed to establish that Wallace expressly teaches or suggests the recitations of Claim 6 and the Patent Office has failed to provide any interpretation of Wallace supported by objective evidence which properly maps these recitations to the recitations of Wallace, under MPEP guidelines the Patent Office has not established a *prima facie* case of the unpatentability of Claim 6. For these reasons, Applicant respectfully asks the USPTO to hold Claim 6 allowable and to issue a Notice of Allowability of same.

Further, as the Patent Office has failed to address the express recitations of Claim 6 in the Office Action, it may be the case that the Patent Office is improperly<sup>15</sup> rejecting Claim 6 based on its dependency from rejected Claim 1. If such is the case, Applicant respectfully requests that the Patent Office properly hold Claim 6 "objected to" as being dependent on a rejected base claim and not "rejected."

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<sup>15</sup> If a claim is otherwise allowable but is dependent on a canceled claim or on a rejected claim, the Office action should state that the claim would be allowable if rewritten in independent form. MPEP 707.07(j) "State When Claims Are Allowable"



### G. Claim 7 Independently Patentable

The Patent Office has stated: "Claims 1-9, 13, 15, 18 and 22-48 are rejected under 35 U.S.C. 102(b) as being anticipated by over Wallace et al. (US 3,860,796)." See *Office Action*, p. 2 (30 November 2009).

Claim 7 recites as follows: "the at least one three-dimensional configuration is directly accessible by physically separating the at least one outer material into at least two parts." (Emphasis added).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference...The identical invention must be shown in as complete detail as is contained in the...claim...The elements must be arranged as required by the claim..." MPEP § 2131 (emphasis added).

With respect to Claim 7, the Patent Office has failed to provide any objective evidence that demonstrates that the Wallace may be interpreted to teach or suggest that "the...three-dimensional configuration is directly accessible by physically separating the at least one outer material into at least two parts" as in Claim 7. Specifically, following Applicant's reading of the Office Action, it does not appear that the Patent Office has even addressed Claim 7 in the Office Action outside of its blanket rejection of "Claims 1-9, 13, 15, 18 and 22-48."

Because the Patent Office failed to establish that Wallace expressly teaches or suggests the recitations of Claim 7 and the Patent Office has failed to provide any interpretation of Wallace supported by objective evidence which properly maps these recitations to the recitations of Wallace, under MPEP guidelines the Patent Office has not established a *prima facie* case of the unpatentability of Claim 7. For these reasons, Applicant respectfully asks the USPTO to hold Claim 7 allowable and to issue a Notice of Allowability of same.

Further, as the Patent Office has failed to address the express recitations of Claim 7 in the Office Action, it may be the case that the Patent Office is improperly<sup>16</sup>

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<sup>16</sup> If a claim is otherwise allowable but is dependent on a canceled claim or on a rejected claim, the Office action should state that the claim would be allowable if rewritten in independent form. MPEP 707.07(j) "State When Claims Are Allowable"

rejecting Claim 7 based on its dependency from rejected Claim 1. If such is the case, Applicant respectfully requests that the Patent Office properly hold Claim 7 "objected to" as being dependent on a rejected base claim and not "rejected."

#### **H. Claim 8 Independently Patentable**

The Patent Office has stated: "Claims 1-9, 13, 15, 18 and 22-48 are rejected under 35 U.S.C. 102(b) as being anticipated by over Wallace et al. (US 3,860,796)." See *Office Action*, p. 2 (30 November 2009).

Claim 8 recites as follows: "the at least one three-dimensional configuration is directly accessible only by disassembling the item."

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference...The identical invention must be shown in as complete detail as is contained in the...claim...The elements must be arranged as required by the claim..." MPEP § 2131 (emphasis added).

With respect to Claim 8, the Patent Office has failed to provide any objective evidence that demonstrates that the Wallace may be interpreted to teach or suggest that "the at least one three-dimensional configuration is directly accessible only by disassembling the item" as in Claim 8. Specifically, following Applicant's reading of the Office Action, it does not appear that the Patent Office has even addressed Claim 8 in the Office Action outside of its blanket rejection of "Claims 1-9, 13, 15, 18 and 22-48."

Because the Patent Office failed to establish that Wallace expressly teaches or suggests the recitations of Claim 8 and the Patent Office has failed to provide any interpretation of Wallace supported by objective evidence which properly maps these recitations to the recitations of Wallace, under MPEP guidelines the Patent Office has not established a *prima facie* case of the unpatentability of Claim 8. For these reasons, Applicant respectfully asks the USPTO to hold Claim 8 allowable and to issue a Notice of Allowability of same.

Further, as the Patent Office has failed to address the express recitations of Claim 8 in the Office Action, it may be the case that the Patent Office is improperly<sup>17</sup> rejecting Claim 8 based on its dependency from rejected Claim 1. If such is the case, Applicant respectfully requests that the Patent Office properly hold Claim 8 "objected to" as being dependent on a rejected base claim and not "rejected."

#### **I. Claim 9 Independently Patentable**

The Patent Office has stated: "Claims 1-9, 13, 15, 18 and 22-48 are rejected under 35 U.S.C. 102(b) as being anticipated by over Wallace et al. (US 3,860,796)." See *Office Action*, p. 2 (30 November 2009).

Claim 9 recites as follows: "the at least one identifying material emits identifying electromagnetic radiation when irradiated with specified electromagnetic radiation."

Applicant respectfully asserts herein that, under the MPEP and legal standards for patentability, the Patent Office has failed to establish a *prima facie* case of the unpatentability of Applicant's claims at issue. Specifically, Applicant respectfully shows below that: 1) the technical references cited by the Patent Office do not recite the text of Applicant's claims; and 2) has the Patent Office failed to provide an interpretation of those technical references supported by objective evidence which reconciles those differences. Accordingly, Applicant respectfully requests that the Patent Office withdraw its rejections and hold Claim 9 to be allowable over the Patent Office-cited references.

#### **1. Significant Distinctions Exist Between the Wallace Reference Cited by the Patent Office and Applicant's Claim 9; The Patent Office has Failed to Provide Objective Evidence Supporting Its Interpretation of Claim 9 and/or Wallace**

With respect to Claim 9, the Patent Office has stated:

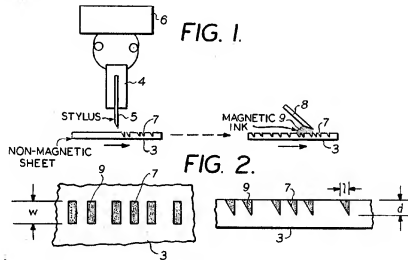
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<sup>17</sup> If a claim is otherwise allowable but is dependent on a canceled claim or on a rejected claim, the Office action should state that the claim would be allowable if rewritten in independent form. MPEP 707.07(j) "State When Claims Are Allowable"

Wallace teaches...at least one identifying material (magnetic ink paste 9) filling at least part of a cavity in the at least one outer material...;

See *Office Action*, pp. 2-3. (Emphasis added).

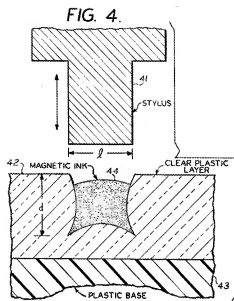
Applicant respectfully points out that Wallace does not actually recite as suggested by the Patent Office. Rather, the portions of Wallace cited by the Patent Office recite as follows:



See Wallace, FIGS. 1 and 2

The stylus strikes the surface of the record member 3, leaving a line of indentations 7 spaced in an alpha-numeric code form. The presence of an indentation, for example, may represent the binary "1" signal and the absence, the binary "0" signal. The record member can usually be passed under the recording head at a rate of 1 to 50 inches per second. After being indented, the record member next has a magnetic ink paste 9 squeezed into the indentations, as by a blade 8. The surface of the card may then be wiped, if necessary, and the ink is allowed to cure.

See Wallace, col. 2, lines 41-53 (Emphasis added).



See Wallace, FIG. 4

A plastic card comprised of a plastic base layer 43 with a clear plastic top coating 42 is overcoated with a layer of a magnetic ink or paste (not shown) in the area to be indented, and the ink is partially pre-dried, if desired, to some extent. A blunt end stylus 41 is then used to indent the card in the manner previously described and force the ink 44 into the indentation.

See Wallace, col. 3, lines 41-47

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference...The identical invention must be shown in as complete detail as is contained in the...claim...The elements must be arranged as required by the claim..." MPEP § 2131 (emphasis added).

Applicant has reviewed the Patent Office-cited portions of Wallace (i.e. those portions which must support a case of unpatentability on their face) and, as can be seen from the foregoing, the Patent Office failed to provide any evidence to support its allegations that Wallace expressly teaches or suggests the all the claim features of Claim 9.

As noted, Claim 9 recites: “the at least one identifying material emits identifying electromagnetic radiation when irradiated with specified electromagnetic radiation.” (Emphasis added)

In contrast, Wallace merely recites: “magnetic ink paste.”

As can be seen from the directly quoted portions of Wallace and Applicant's claims, significant distinctions exist between the express recitations of Wallace and the Applicant's claims (e.g. Wallace's failure to expressly recite that the “identifying material emits identifying electromagnetic radiation when irradiated with specified electromagnetic radiation.”)

As such, the burden rests on the Patent Office to provide an interpretation of Wallace and Claim 9 supported by objective evidence that “bridges the gap” between the actual recitations of Wallace and the actual recitations of Applicant's claims. In its attempt to account for those significant distinctions, it appears to Applicant that the Patent Office has mapped the recitations of a “three-dimensional configuration being embedded within the at least one outer material” of Claim 9 onto “magnetic ink paste.”

As can be seen from the directly quoted portions of the Patent Office rejection of Claim 9, the Patent Office has failed to provide objective evidence that demonstrates that “magnetic ink paste” of Wallace may be interpreted to teach or suggest a “three-dimensional configuration being embedded within the at least one outer material” as in Claim 9. Particularly, Applicant respectfully submits that the Patent Office has not explained how it reaches such mappings under the broadest reasonable interpretation framework<sup>18</sup> as is the Patent Office's burden (e.g., such as by examples drawn from Applicant's claims or detailed description). Applicant points out that although Claim 9 has been quoted in the present rejection, several

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<sup>18</sup> During patent examination, the Patent Office determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004).

claim terms have not been addressed<sup>19</sup> in the Patent Office's analysis (e.g. at least the recitations "embedded within").

What a reference "teaches" is a question of fact. Conclusory statements that a reference "teaches" something beyond its bare recitations/direct disclosures do not constitute ANY evidence of such "teachings" unless they are supported by objective evidence. See *In re McNeil-PPC*, 2008-1546 (Fed. Cir. July 31, 2009); *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

Thus, when a party to a matter asserts that a reference "teaches" something beyond its bare recitations/direct disclosure, and that factual assertion is challenged by an opposite party, the law requires that the asserting party provide objective evidentiary support to "close the gap" between what the reference actually recites and what the asserting party alleges the reference teaches. In the absence of such evidence, there should be no finding of fact in favor of the asserted teaching.

Because the Patent Office failed to establish that Wallace expressly teaches or suggests the recitations of Claim 9 and the Patent Office has failed to provide an interpretation of Wallace supported by objective evidence which properly maps these recitations to the recitations of Wallace, under MPEP guidelines the Patent Office has not established a *prima facie* case of the unpatentability of Claim 9. For these reasons, Applicant respectfully asks the USPTO to hold Claim 9 allowable and to issue a Notice of Allowability of same.

#### **J. Claim 13**

The Patent Office has stated: "Claim[] 13...[is] rejected under 35 U.S.C. 102(b) as being anticipated by Wallace et al. (US 3,860,796)." See *Office Action*, p. 2 (30 November 2009).

Claim 13 recites as follows: " A method of identifying an item comprising: a) detecting an at least one three-dimensional configuration with a penetrating imaging tool, the detecting an at least one three-dimensional configuration with a

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<sup>19</sup> "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

penetrating imaging tool resulting in an output from the penetrating imaging tool; and b) reading identifying information by interpreting the output.”<sup>20</sup>

Applicant respectfully asserts herein that, under the MPEP and legal standards for patentability, the Patent Office has failed to establish a *prima facie* case of the unpatentability of Applicant's claims at issue. Specifically, Applicant respectfully shows below that: 1) the technical references cited by the Patent Office do not recite the text of Applicant's claims; and 2) has the Patent Office failed to provide an interpretation of those technical references supported by objective evidence which reconciles those differences. Accordingly, Applicant respectfully requests that the Patent Office withdraw its rejections and hold Claim 13 to be allowable over the Patent Office-cited references.

**1. The Patent Office has Failed to Provide Objective Evidence Supporting Its Interpretation of Claim 13 and/or Wallace**

With respect to Claim 13, the Patent Office has stated:

Wallace teaches...a method of identifying an item comprising: detecting an at least one three-dimensional configuration with a penetrating imaging tool, the detecting an at least one three-dimensional configuration with a penetrating imaging tool resulting in an output from the penetrating imaging tool; and reading identifying information by interpreting the output;

See *Office Action*, pp. 2-3.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference...The identical invention must be shown in as complete detail as is contained in the...claim...The elements must be arranged as required by the claim...” MPEP § 2131 (emphasis added).

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art

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<sup>20</sup> The lettering of the clauses herein is merely for sake of clarity of argument and should not be taken to imply any particular ordering of the clauses.



reference...The identical invention must be shown in as complete detail as is contained in the...claim...The elements must be arranged as required by the claim..." MPEP § 2131 (emphasis added).

As can be seen from the directly quoted portions of the Patent Office rejection of Claim 13, the Patent Office has failed to provide any objective evidence that demonstrates that the Wallace may be interpreted to teach or suggest "detecting an at least one three-dimensional configuration with a penetrating imaging tool, the detecting an at least one three-dimensional configuration with a penetrating imaging tool resulting in an output from the penetrating imaging tool" or reading identifying information by interpreting the output" as in Claim 13. While Claim 3 has been quoted in the present rejection, several claim terms have not been addressed<sup>21</sup> in the Patent Office's analysis (e.g. at least the recitations "embedded within").

What a reference "teaches" is a question of fact. Conclusory statements that a reference "teaches" something beyond its bare recitations/direct disclosures do not constitute ANY evidence of such "teachings" unless they are supported by objective evidence. See *In re McNeil-PPC*, 2008-1546 (Fed. Cir. July 31, 2009); *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

Thus, when a party to a matter asserts that a reference "teaches" something beyond its bare recitations/direct disclosure, and that factual assertion is challenged by an opposite party, the law requires that the asserting party provide objective evidentiary support to "close the gap" between what the reference actually recites and what the asserting party alleges the reference teaches. In the absence of such evidence, there should be no finding of fact in favor of the asserted teaching.

Because the Patent Office failed to establish that Wallace expressly teaches or suggests the recitations of Claim 13 and the Patent Office has failed to provide an interpretation of Wallace supported by objective evidence which properly maps these recitations to the recitations of Wallace, under MPEP guidelines the Patent Office has not established a *prima facie* case of the unpatentability of Claim 13.

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<sup>21</sup> "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

For these reasons, Applicant respectfully asks the USPTO to hold Claim 13 allowable and to issue a Notice of Allowability of same.

**2. The Patent Office's Interpretation of Wallace Appears to be Based on Inadvertent Impermissible Hindsight, Personal Knowledge, or Official Notice**

Applicant respectfully points out that the Applicant's Application is the only objectively verifiable Patent Office-cited document of record that shows or suggests what the Patent Office purports the Wallace reference to teach. From this and the express recitations of Wallace as set forth above, it follows that the Patent Office may be interpreting Wallace through the lens of Applicant's application, which is impermissible hindsight use. If such is the case, at present, the Patent Office's assertions regarding Wallace are untenable.

Further, as the Patent Office has provided no objectively verifiable evidence, nor argument based on objectively verifiable evidence, in support of the Patent Office interpretation regarding what the technical material cited by the Patent Office "teaches," Applicant infers that the Patent Office may be relying on "personal knowledge" and/or is taking "official notice" of one or more factors to reach the factual conclusion of what the cited technical material "teaches" but has failed to expressly acknowledge as such in the written record.

In view of the foregoing, if the Patent Office desires to maintain the rejection, in the next communication, Applicant respectfully requests that the Patent Office provide an affidavit or declaration setting forth objectively verifiable evidence in support of the Patent Office's currently unsupported assertions regarding what the cited technical material "teaches" and/or should be interpreted to "teach." See, e.g., MPEP § 2144.03(C), *If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Patent Office Must Support the Finding with Adequate Evidence*, and 37 C.F.R. 1.104(d)(2).

Absent an affidavit setting forth such objectively verifiable evidence supporting the Patent Office's interpretation of Wallace, under MPEP standards, the Patent Office has not established a *prima facie* case that the Patent Office-cited

references of record render Claim 13 *prima facie* unpatentable. Applicant respectfully asks the Patent Office to hold Claim 13 allowable and to issue a Notice of Allowance of same.

**K. Claims 14-21 Patentable for at Least Reasons of Dependency from Claim 13**

Claims 14-21 depend either directly or indirectly from Claim 13. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." See 35 U.S.C. § 112 paragraph 4. Consequently, Claims 14-21 are patentable for at least the reasons why Claim 13 is patentable. Accordingly, Applicant respectfully requests that The Patent Office hold Claims 14-21 patentable for at least the foregoing reasons, and issue a Notice of Allowability on same.

**L. Claim 22**

The Patent Office has stated: "Claim[...]22 is] rejected under 35 U.S.C. 102(b) as being anticipated by Wallace et al. (US 3,860,796)." See *Office Action*, p. 2 (30 November 2009).

Claim 22 recites as follows: "A method of making an item, the method comprising: a) forming at least one portion of the item from at least one structural material; and b) integrally with said forming the at least one portion, enclosing within the at least one structural material identifying information that identifies the item, the identifying information including at least one three-dimensional configuration corresponding to the identifying information, the at least one three-dimensional configuration including at least one of (1) a void substantially shaped as the at least one three-dimensional configuration, the void defined by the at least one structural material, or (2) an identifying material substantially shaped as at least part of the at least one three-dimensional configuration, wherein the at least one structural material is substantially opaque to visible light."<sup>22</sup>

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<sup>22</sup> The lettering of the clauses herein is merely for sake of clarity of argument and should not be taken to imply any particular ordering of the clauses.

Applicant respectfully asserts herein that, under the MPEP and legal standards for patentability, the Patent Office has failed to establish a *prima facie* case of the unpatentability of Applicant's claims at issue. Specifically, Applicant respectfully shows below that: 1) the technical references cited by the Patent Office do not recite the text of Applicant's claims; and 2) has the Patent Office failed to provide an interpretation of those technical references supported by objective evidence which reconciles those differences. Accordingly, Applicant respectfully requests that the Patent Office withdraw its rejections and hold Claim 22 to be allowable over the Patent Office-cited references.

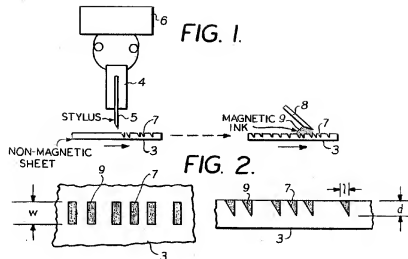
**1. Significant Distinctions Exist Between the Wallace Reference Cited by the Patent Office and Applicant's Claim 22; The Patent Office has Failed to Provide Objective Evidence Supporting Its Interpretation of Claim 22 and/or Wallace**

With respect to Claim 22, the Patent Office has stated:

Wallace teaches an item comprising: an outer part (member 3) including at least one outer material (plastic 20 mils thick) (col. 2, lines 63-64); and an identifier including at least one three-dimensional configuration corresponding to the identifier, the at least one three-dimensional configuration being embedded within the at least one outer material and including at least one of (1) a substantially empty cavity in the at least one outer material, or (2) at least one identifying material (magnetic ink paste 9) filling at least part of a cavity in the at least one outer material and wherein the at least one outer material in which the at least one identifying material fills at least part of the cavity is substantially opaque to visible light;

See *Office Action*, pp. 2-3. (Emphasis added).

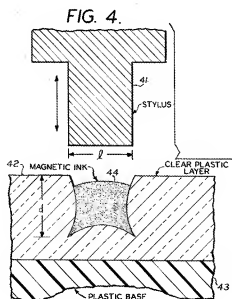
Applicant respectfully points out that Wallace does not actually recite as suggested by the Patent Office. Rather, the portions of Wallace cited by the Patent Office recite as follows:



See Wallace, FIGs. 1 and 2

The stylus strikes the surface of the record member 3, leaving a line of indentations 7 spaced in an alpha-numeric code form. The presence of an indentation, for example, may represent the binary "1" signal and the absence, the binary "0" signal. The record member can usually be passed under the recording head at a rate of 1 to 50 inches per second. After being indented, the record member next has a magnetic ink paste 9 squeezed into the indentations, as by a blade 8. The surface of the card may then be wiped, if necessary, and the ink is allowed to cure.

See Wallace, col. 2, lines 41-53 (Emphasis added).



See Wallace, FIG. 4

A plastic card comprised of a plastic base layer 43 with a clear plastic top coating 42 is overcoated with a layer of a magnetic ink or paste (not shown) in the area to be indented, and the ink is partially pre-dried, if desired, to some extent. A blunt end stylus 41 is then used to indent the card in the manner previously described and force the ink 44 into the indentation.

See Wallace, col. 3, lines 41-47

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference...The identical invention must be shown in as complete detail as is contained in the...claim...The elements must be arranged as required by the claim..." MPEP § 2131 (emphasis added).

Applicant has reviewed the Patent Office-cited portions of Wallace (i.e. those portions which must support a case of unpatentability on their face) and, as can be seen from the foregoing, the Patent Office failed to provide any evidence to support its allegations that Wallace expressly teaches or suggests the all the claim features of clause [b] of Claim 22.

As noted, clause [b] of Claim 22 recites: "[b] enclosing within the at least one structural material identifying information that identifies the item, the identifying information including at least one three-dimensional configuration corresponding to the identifying information." (Emphasis added)

In contrast, Wallace merely recites: "The stylus strikes the surface of the record member 3, leaving a line of indentations...and magnetic ink paste 9 [is] squeezed into the indentations" or that "[a] blunt end stylus...is then used to indent the card in the manner previously described and force the ink...into the indentation."

As can be seen from the directly quoted portions of Wallace and Applicant's claims, significant distinctions exist between the express recitations of Wallace and the Applicant's claims (e.g. Wallace's failure to expressly recite a "three-dimensional configuration being embedded within the at least one outer material.")

As such, the burden rests on the Patent Office to provide an interpretation of Wallace and Claim 22 supported by objective evidence that "bridges the gap" between the actual recitations of Wallace and the actual recitations of Applicant's claims. In its attempt to account for those significant distinctions it appears to Applicant that the Patent Office has mapped the recitations "enclosing within the...structural material...at least one three-dimensional configuration corresponding to the identifying information" of Claim 22 onto "a line of indentations."

As can be seen from the directly quoted portions of the Patent Office rejection of Claim 22, the Patent Office has failed to provide objective evidence that demonstrates that "a line of indentations" of Wallace may be interpreted to teach or suggest "enclosing within the...structural material...at least one three-dimensional configuration corresponding to the identifying information" as in Claim 22. Particularly, Applicant respectfully submits that the Patent Office has not explained how it reaches such mappings under the broadest reasonable interpretation framework<sup>23</sup> as is the Patent Office's burden (e.g., such as by examples drawn from Applicant's claims or detailed description). Applicant points out that although Claim 22 has been quoted in the present rejection, several claim terms have not been addressed<sup>24</sup> in the Patent Office's analysis (e.g. at least the recitations "enclosing within").

What a reference "teaches" is a question of fact. Conclusory statements that a reference "teaches" something beyond its bare recitations/direct disclosures do not constitute ANY evidence of such "teachings" unless they are supported by objective evidence. See *In re McNeil-PPC*, 2008-1546 (Fed. Cir. July 31, 2009); *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

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<sup>23</sup> During patent examination, the Patent Office determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004).

<sup>24</sup> "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Thus, when a party to a matter asserts that a reference “teaches” something beyond its bare recitations/direct disclosure, and that factual assertion is challenged by an opposite party, the law requires that the asserting party provide objective evidentiary support to “close the gap” between what the reference actually recites and what the asserting party alleges the reference teaches. In the absence of such evidence, there should be no finding of fact in favor of the asserted teaching.

Because the Patent Office failed to establish that Wallace expressly teaches or suggests the recitations of Claim 22 and the Patent Office has failed to provide an interpretation of Wallace supported by objective evidence which properly maps these recitations to the recitations of Wallace, under MPEP guidelines the Patent Office has not established a *prima facie* case of the unpatentability of Claim 22. For these reasons, Applicant respectfully asks the USPTO to hold Claim 22 allowable and to issue a Notice of Allowability of same.

**2. The Patent Office's Interpretation of Wallace Appears to be Based on Inadvertent Impermissible Hindsight, Personal Knowledge, or Official Notice**

Applicant respectfully points out that the Applicant's Application is the only objectively verifiable Patent Office-cited document of record that shows or suggests what the Patent Office purports the Wallace reference to teach. From this and the express recitations of Wallace as set forth above, it follows that the Patent Office may be interpreting Wallace through the lens of Applicant's application, which is impermissible hindsight use. If such is the case, at present, the Patent Office's assertions regarding Wallace are untenable.

Further, as the Patent Office has provided no objectively verifiable evidence, nor argument based on objectively verifiable evidence, in support of the Patent Office interpretation regarding what the technical material cited by the Patent Office “teaches,” Applicant infers that the Patent Office may be relying on “personal knowledge” and/or is taking “official notice” of one or more factors to reach the factual conclusion of what the cited technical material “teaches” but has failed to expressly acknowledge as such in the written record.



In view of the foregoing, if the Patent Office desires to maintain the rejection, in the next communication, Applicant respectfully requests that the Patent Office provide an affidavit or declaration setting forth objectively verifiable evidence in support of the Patent Office's currently unsupported assertions regarding what the cited technical material "teaches" and/or should be interpreted to "teach." See, e.g., MPEP § 2144.03(C), *If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Patent Office Must Support the Finding with Adequate Evidence*, and 37 C.F.R. 1.104(d)(2).

Absent an affidavit setting forth such objectively verifiable evidence supporting the Patent Office's interpretation of Wallace, under MPEP standards, the Patent Office has not established a *prima facie* case that the Patent Office-cited references of record render Claim 22 *prima facie* unpatentable. Applicant respectfully asks the Patent Office to hold Claim 22 allowable and to issue a Notice of Allowance of same.

**M. Claims 23-33 Patentable for at Least Reasons of Dependency from Claim 22**

Claims 23-33 depend either directly or indirectly from Claim 22. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." See 35 U.S.C. § 112 paragraph 4. Consequently, Claims 23-33 are patentable for at least the reasons why Claim 22 is patentable. Accordingly, Applicant respectfully requests that The Patent Office hold Claims 23-33 patentable for at least the foregoing reasons, and issue a Notice of Allowability on same.

**N. Claim 34**

The Patent Office has stated: "Claim[]...[34 is] rejected under 35 U.S.C. 102(b) as being anticipated by Wallace et al. (US 3,860,796)." See *Office Action*, p. 2 (30 November 2009).

Claim 34 recites as follows: " A method of making an item, the method comprising: a) forming at least one portion of the item from at least one structural material; and b) integrally with the forming the at least one portion, enclosing within the at least one structural material a void substantially shaped as at least one three dimensional configuration corresponding to identifying information that identifies the item, the void being defined by the at least one structural material." <sup>25</sup>

Applicant respectfully asserts herein that, under the MPEP and legal standards for patentability, the Patent Office has failed to establish a *prima facie* case of the unpatentability of Applicant's claims at issue. Specifically, Applicant respectfully shows below that: 1) the technical references cited by the Patent Office do not recite the text of Applicant's claims; and 2) has the Patent Office failed to provide an interpretation of those technical references supported by objective evidence which reconciles those differences. Accordingly, Applicant respectfully requests that the Patent Office withdraw its rejections and hold Claim 34 to be allowable over the Patent Office-cited references.

**1. Significant Distinctions Exist Between the Wallace Reference Cited by the Patent Office and Applicant's Claim 34; The Patent Office has Failed to Provide Objective Evidence Supporting Its Interpretation of Claim 34 and/or Wallace**

With respect to Claim 34, the Patent Office has stated:

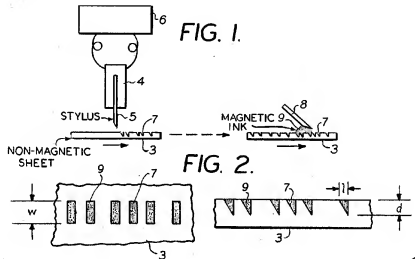
Wallace teaches an item comprising: an outer part (member 3) including at least one outer material (plastic 20 mils thick) (col. 2, lines 63-64); and an identifier including at least one three-dimensional configuration corresponding to the identifier, the at least one three-dimensional configuration being embedded within the at least one outer material and including at least one of (1) a substantially empty cavity in the at least one outer material, or (2) at least one identifying material (magnetic ink paste 9) filling at least part of a cavity in the at least one outer material and wherein the at least one outer material in which the at least one identifying material fills at least part of the cavity is substantially opaque to visible light;

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<sup>25</sup> The lettering of the clauses herein is merely for sake of clarity of argument and should not be taken to imply any particular ordering of the clauses.

See *Office Action*, pp. 2-3. (Emphasis added).

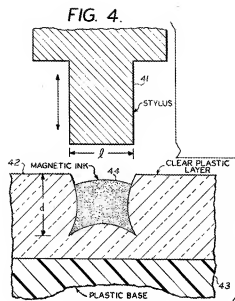
Applicant respectfully points out that Wallace does not actually recite as suggested by the Patent Office. Rather, the portions of Wallace cited by the Patent Office recite as follows:



See Wallace, FIGs. 1 and 2

The stylus strikes the surface of the record member 3, leaving a line of indentations 7 spaced in an alpha-numeric code form. The presence of an indentation, for example, may represent the binary "1" signal and the absence, the binary "0" signal. The record member can usually be passed under the recording head at a rate of 1 to 50 inches per second. After being indented, the record member next has a magnetic ink paste 9 squeezed into the indentations, as by a blade 8. The surface of the card may then be wiped, if necessary, and the ink is allowed to cure.

See Wallace, col. 2, lines 41-53 (Emphasis added).



See Wallace, FIG. 4

A plastic card comprised of a plastic base layer 43 with a clear plastic top coating 42 is overcoated with a layer of a magnetic ink or paste (not shown) in the area to be indented, and the ink is partially pre-dried, if desired, to some extent. A blunt end stylus 41 is then used to indent the card in the manner previously described and force the ink 44 into the indentation.

See Wallace, col. 3, lines 41-47

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference...The identical invention must be shown in as complete detail as is contained in the...claim...The elements must be arranged as required by the claim..." MPEP § 2131 (emphasis added).

Applicant has reviewed the Patent Office-cited portions of Wallace (i.e. those portions which must support a case of unpatentability on their face) and, as can be seen from the foregoing, the Patent Office failed to provide any evidence to support its allegations that Wallace expressly teaches or suggests the all the claim features of clause [b] of Claim 34.

As noted, clause [b] of Claim 34 recites: "[b] enclosing within the at least one structural material a void substantially shaped as at least one three

dimensional configuration corresponding to identifying information that identifies the item.” (Emphasis added)

In contrast, Wallace merely recites: “The stylus strikes the surface of the record member 3, leaving a line of indentations...and magnetic ink paste 9 [is] squeezed into the indentations” or that “[a] blunt end stylus...is then used to indent the card in the manner previously described and force the ink...into the indentation.”

As can be seen from the directly quoted portions of Wallace and Applicant's claims, significant distinctions exist between the express recitations of Wallace and the Applicant's claims (e.g. Wallace's failure to expressly recite a “enclosing within the at least one structural material a void substantially shaped as at least one three dimensional configuration corresponding to identifying information.”)

As such, the burden rests on the Patent Office to provide an interpretation of Wallace and Claim 34 supported by objective evidence that “bridges the gap” between the actual recitations of Wallace and the actual recitations of Applicant's claims. In its attempt to account for those significant distinctions it appears to Applicant that the Patent Office has mapped the recitations “enclosing within the...structural material...at least one three-dimensional configuration corresponding to the identifying information” of Claim 34 onto “a line of indentations.”

As can be seen from the directly quoted portions of the Patent Office rejection of Claim 34, the Patent Office has failed to provide objective evidence that demonstrates that “a line of indentations” of Wallace may be interpreted to teach or suggest “enclosing within the at least one structural material a void substantially shaped as at least one three dimensional configuration corresponding to identifying information” as in Claim 34. Particularly, Applicant respectfully submits that the Patent Office has not explained how it reaches such mappings under the broadest reasonable interpretation framework<sup>26</sup> as is the Patent Office's burden (e.g., such

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<sup>26</sup> During patent examination, the Patent Office determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of

as by examples drawn from Applicant's claims or detailed description). Applicant points out that although Claim 34 has been quoted in the present rejection, several claim terms have not been addressed<sup>27</sup> in the Patent Office's analysis (e.g. at least the recitations "enclosing within").

What a reference "teaches" is a question of fact. Conclusory statements that a reference "teaches" something beyond its bare recitations/direct disclosures do not constitute ANY evidence of such "teachings" unless they are supported by objective evidence. See *In re McNeil-PPC*, 2008-1546 (Fed. Cir. July 31, 2009); *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

Thus, when a party to a matter asserts that a reference "teaches" something beyond its bare recitations/direct disclosure, and that factual assertion is challenged by an opposite party, the law requires that the asserting party provide objective evidentiary support to "close the gap" between what the reference actually recites and what the asserting party alleges the reference teaches. In the absence of such evidence, there should be no finding of fact in favor of the asserted teaching.

Because the Patent Office failed to establish that Wallace expressly teaches or suggests the recitations of Claim 34 and the Patent Office has failed to provide an interpretation of Wallace supported by objective evidence which properly maps these recitations to the recitations of Wallace, under MPEP guidelines the Patent Office has not established a *prima facie* case of the unpatentability of Claim 34. For these reasons, Applicant respectfully asks the USPTO to hold Claim 34 allowable and to issue a Notice of Allowability of same.

## **2. The Patent Office's Interpretation of Wallace Appears to be Based on Inadvertent Impermissible Hindsight, Personal Knowledge, or Official Notice**

Applicant respectfully points out that the Applicant's Application is the only objectively verifiable Patent Office-cited document of record that shows or suggests

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**ordinary skill in the art."** *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004).

<sup>27</sup> "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

what the Patent Office purports the Wallace reference to teach. From this and the express recitations of Wallace as set forth above, it follows that the Patent Office may be interpreting Wallace through the lens of Applicant's application, which is impermissible hindsight use. If such is the case, at present, the Patent Office's assertions regarding Wallace are untenable.

Further, as the Patent Office has provided no objectively verifiable evidence, nor argument based on objectively verifiable evidence, in support of the Patent Office interpretation regarding what the technical material cited by the Patent Office "teaches," Applicant infers that the Patent Office may be relying on "personal knowledge" and/or is taking "official notice" of one or more factors to reach the factual conclusion of what the cited technical material "teaches" but has failed to expressly acknowledge as such in the written record.

In view of the foregoing, if the Patent Office desires to maintain the rejection, in the next communication, Applicant respectfully requests that the Patent Office provide an affidavit or declaration setting forth objectively verifiable evidence in support of the Patent Office's currently unsupported assertions regarding what the cited technical material "teaches" and/or should be interpreted to "teach." See, e.g., MPEP § 2144.03(C), *If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Patent Office Must Support the Finding with Adequate Evidence*, and 37 C.F.R. 1.104(d)(2).

Absent an affidavit setting forth such objectively verifiable evidence supporting the Patent Office's interpretation of Wallace, under MPEP standards, the Patent Office has not established a *prima facie* case that the Patent Office-cited references of record render Claim 34 *prima facie* unpatentable. Applicant respectfully asks the Patent Office to hold Claim 34 allowable and to issue a Notice of Allowance of same.

**O. Claims 35-36 Patentable for at Least Reasons of Dependency from Claim 34**

Claims 35-36 depend either directly or indirectly from Claim 34. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." See 35 U.S.C. § 112 paragraph 4. Consequently, Claims 35-36 are patentable for at least the reasons why Claim 34 is patentable. Accordingly, Applicant respectfully requests that The Patent Office hold Claims 35-36 patentable for at least the foregoing reasons, and issue a Notice of Allowability on same.

**P. Claim 37**

The Patent Office has stated: "Claim[]...[34 is] rejected under 35 U.S.C. 102(b) as being anticipated by Wallace et al. (US 3,860,796)." See *Office Action*, p. 2 (30 November 2009).

Claim 37 recites as follows: "A method of forming a computer-readable representation of an item, the method comprising: forming an outer surface computer-readable representation part including a representation of the outer surface of the item; forming an identifying surface computer-readable representation part of at least one closed three-dimensional identifying surface, the at least one identifying surface corresponding to identifying information that identifies the item, and the at least one identifying surface being contained within the outer surface; and associating the outer surface computer-readable representation part and the identifying surface computer-readable representation part."

Applicant respectfully asserts herein that, under the MPEP and legal standards for patentability, the Patent Office has failed to establish a *prima facie* case of the unpatentability of Applicant's claims at issue. Specifically, Applicant respectfully shows below that: 1) the technical references cited by the Patent Office do not recite the text of Applicant's claims; and 2) has the Patent Office failed to provide an interpretation of those technical references supported by objective evidence which reconciles those differences. Accordingly, Applicant respectfully



requests that the Patent Office withdraw its rejections and hold Claim 37 to be allowable over the Patent Office-cited references.

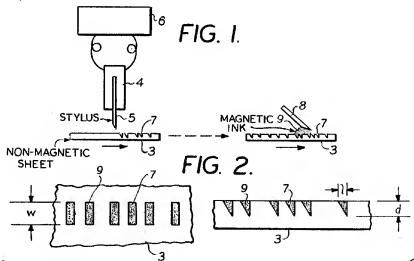
**1. Significant Distinctions Exist Between the Wallace Reference Cited by the Patent Office and Applicant's Claim 37; The Patent Office has Failed to Provide Objective Evidence Supporting Its Interpretation of Claim 37 and/or Wallace**

With respect to Claim 37, the Patent Office has stated:

Wallace teaches an item comprising: an outer part (member 3) including at least one outer material (plastic 20 mils thick) (col. 2, lines 63-64); and an identifier including at least one three-dimensional configuration corresponding to the identifier, the at least one three-dimensional configuration being embedded within the at least one outer material and including at least one of (1) a substantially empty cavity in the at least one outer material, or (2) at least one identifying material (magnetic ink paste 9) filling at least part of a cavity in the at least one outer material and wherein the at least one outer material in which the at least one identifying material fills at least part of the cavity is substantially opaque to visible light;

See *Office Action*, pp. 2-3. (Emphasis added).

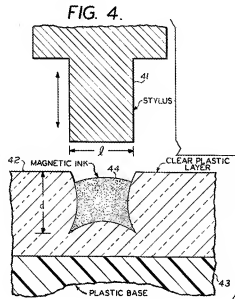
Applicant respectfully points out that Wallace does not actually recite as suggested by the Patent Office. Rather, the portions of Wallace cited by the Patent Office recite as follows:



See Wallace, FIGs. 1 and 2

The stylus strikes the surface of the record member 3, leaving a line of indentations 7 spaced in an alpha-numeric code form. The presence of an indentation, for example, may represent the binary "1" signal and the absence, the binary "0" signal. The record member can usually be passed under the recording head at a rate of 1 to 50 inches per second. After being indented, the record member next has a magnetic ink paste 9 squeezed into the indentations, as by a blade 8. The surface of the card may then be wiped, if necessary, and the ink is allowed to cure.

See Wallace, col. 2, lines 41-53 (Emphasis added).



See Wallace, FIG. 4

A plastic card comprised of a plastic base layer 43 with a clear plastic top coating 42 is overcoated with a layer of a magnetic ink or paste (not shown) in the area to be indented, and the ink is partially pre-dried, if desired, to some extent. A blunt end stylus 41 is then used to indent the card in the manner previously described and force the ink 44 into the indentation.

See Wallace, col. 3, lines 41-47

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art

reference...The identical invention must be shown in as complete detail as is contained in the...claim...The elements must be arranged as required by the claim..." MPEP § 2131 (emphasis added).

Applicant has reviewed the Patent Office-cited portions of Wallace (i.e. those portions which must support a case of unpatentability on their face) and, as can be seen from the foregoing, the Patent Office failed to provide any evidence to support its allegations that Wallace expressly teaches or suggests the all the claim features of Claim 37.

As noted, Claim 37 recites: "[b] forming an identifying surface computer-readable representation part of at least one closed three-dimensional identifying surface, the at least one identifying surface corresponding to identifying information that identifies the item, and the at least one identifying surface being contained within the outer surface." (Emphasis added)

In contrast, Wallace merely recites: "The stylus strikes the surface of the record member 3, leaving a line of indentations...and magnetic ink paste 9 [is] squeezed into the indentations" or that "[a] blunt end stylus...is then used to indent the card in the manner previously described and force the ink...into the indentation."

As can be seen from the directly quoted portions of Wallace and Applicant's claims, significant distinctions exist between the express recitations of Wallace and the Applicant's claims (e.g. Wallace's failure to expressly recite a "forming... at least one closed three-dimensional identifying surface...the at least one identifying surface being contained within the outer surface")

As such, the burden rests on the Patent Office to provide an interpretation of Wallace and Claim 37 supported by objective evidence that "bridges the gap" between the actual recitations of Wallace and the actual recitations of Applicant's claims. In its attempt to account for those significant distinctions it appears to Applicant that the Patent Office has mapped the recitations "forming... at least one closed three-dimensional identifying surface...the at least one identifying surface being contained within the outer surface" of Claim 37 onto "a line of indentations."

As can be seen from the directly quoted portions of the Patent Office rejection of Claim 37, the Patent Office has failed to provide objective evidence that demonstrates that “a line of indentations” of Wallace may be interpreted to teach or suggest “forming...at least one closed three-dimensional identifying surface...the at least one identifying surface being contained within the outer surface” as in Claim 37. Particularly, Applicant respectfully submits that the Patent Office has not explained how it reaches such mappings under the broadest reasonable interpretation framework<sup>28</sup> as is the Patent Office’s burden (e.g., such as by examples drawn from Applicant’s claims or detailed description). Applicant points out that although Claim 37 has been quoted in the present rejection, several claim terms have not been addressed<sup>29</sup> in the Patent Office’s analysis (e.g. at least the recitations “closed three-dimensional identifying surface”).

What a reference “teaches” is a question of fact. Conclusory statements that a reference “teaches” something beyond its bare recitations/direct disclosures do not constitute ANY evidence of such “teachings” unless they are supported by objective evidence. See *In re McNeil-PPC*, 2008-1546 (Fed. Cir. July 31, 2009); *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

Thus, when a party to a matter asserts that a reference “teaches” something beyond its bare recitations/direct disclosure, and that factual assertion is challenged by an opposite party, the law requires that the asserting party provide objective evidentiary support to “close the gap” between what the reference actually recites and what the asserting party alleges the reference teaches. In the absence of such evidence, there should be no finding of fact in favor of the asserted teaching.

Because the Patent Office failed to establish that Wallace expressly teaches or suggests the recitations of Claim 37 and the Patent Office has failed to provide

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<sup>28</sup> During patent examination, the Patent Office determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004).

<sup>29</sup> “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

an interpretation of Wallace supported by objective evidence which properly maps these recitations to the recitations of Wallace, under MPEP guidelines the Patent Office has not established a *prima facie* case of the unpatentability of Claim 37. For these reasons, Applicant respectfully asks the USPTO to hold Claim 37 allowable and to issue a Notice of Allowability of same.

**2. The Patent Office's Interpretation of Wallace Appears to be Based on Inadvertent Impermissible Hindsight, Personal Knowledge, or Official Notice**

Applicant respectfully points out that the Applicant's Application is the only objectively verifiable Patent Office-cited document of record that shows or suggests what the Patent Office purports the Wallace reference to teach. From this and the express recitations of Wallace as set forth above, it follows that the Patent Office may be interpreting Wallace through the lens of Applicant's application, which is impermissible hindsight use. If such is the case, at present, the Patent Office's assertions regarding Wallace are untenable.

Further, as the Patent Office has provided no objectively verifiable evidence, nor argument based on objectively verifiable evidence, in support of the Patent Office interpretation regarding what the technical material cited by the Patent Office "teaches," Applicant infers that the Patent Office may be relying on "personal knowledge" and/or is taking "official notice" of one or more factors to reach the factual conclusion of what the cited technical material "teaches" but has failed to expressly acknowledge as such in the written record.

In view of the foregoing, if the Patent Office desires to maintain the rejection, in the next communication, Applicant respectfully requests that the Patent Office provide an affidavit or declaration setting forth objectively verifiable evidence in support of the Patent Office's currently unsupported assertions regarding what the cited technical material "teaches" and/or should be interpreted to "teach." See, e.g., MPEP § 2144.03(C), *If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Patent Office Must Support the Finding with Adequate Evidence*, and 37 C.F.R. 1.104(d)(2).

Absent an affidavit setting forth such objectively verifiable evidence supporting the Patent Office's interpretation of Wallace, under MPEP standards, the Patent Office has not established a *prima facie* case that the Patent Office-cited references of record render Claim 37 *prima facie* unpatentable. Applicant respectfully asks the Patent Office to hold Claim 37 allowable and to issue a Notice of Allowance of same.

### **3. Claims 38-42 Patentable for at Least Reasons of Dependency from Claim 34**

Claims 38-42 depend either directly or indirectly from Claim 37. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." See 35 U.S.C. § 112 paragraph 4. Consequently, Claims 38-42 are patentable for at least the reasons why Claim 37 is patentable. Accordingly, Applicant respectfully requests that The Patent Office hold Claims 38-42 patentable for at least the foregoing reasons, and issue a Notice of Allowability on same.

#### **Q. Claim 43**

The Patent Office has stated: "Claim[]...[43 is] rejected under 35 U.S.C. 102(b) as being anticipated by Wallace et al. (US 3,860,796)." See *Office Action*, p. 2 (30 November 2009).

Claim 43 recites as follows: "A method of manufacturing an item, the method comprising: forming a computer-readable representation of the item, the computer-readable representation including a representation of at least one three-dimensional configuration, the at least one three-dimensional configuration corresponding to identifying information that identifies the item; and producing the item using the computer-readable representation of the item, the item including (1) at least one structural material, and (2) the at least one three-dimensional configuration, the at least one three-dimensional configuration including at least one of (a) a void within the at least one structural material, or (b) at least one identifying material substantially shaped as at least part of the at least one three-

dimensional configuration and enclosed within the at least one structural material, wherein the at least one structural material enclosing the at least one identifying material is substantially opaque to visible light.”<sup>30</sup>

Applicant respectfully asserts herein that, under the MPEP and legal standards for patentability, the Patent Office has failed to establish a *prima facie* case of the unpatentability of Applicant's claims at issue. Specifically, Applicant respectfully shows below that: 1) the technical references cited by the Patent Office do not recite the text of Applicant's claims; and 2) has the Patent Office failed to provide an interpretation of those technical references supported by objective evidence which reconciles those differences. Accordingly, Applicant respectfully requests that the Patent Office withdraw its rejections and hold Claim 43 to be allowable over the Patent Office-cited references.

**1. Significant Distinctions Exist Between the Wallace Reference Cited by the Patent Office and Applicant's Claim 43; The Patent Office has Failed to Provide Objective Evidence Supporting Its Interpretation of Claim 43 and/or Wallace**

With respect to Claim 43, the Patent Office has stated:

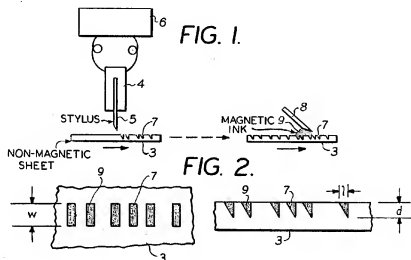
Wallace teaches an item comprising: an outer part (member 3) including at least one outer material (plastic 20 mils thick) (col. 2, lines 63-64); and an identifier including at least one three-dimensional configuration corresponding to the identifier, the at least one three-dimensional configuration being embedded within the at least one outer material and including at least one of (1) a substantially empty cavity in the at least one outer material, or (2) at least one identifying material (magnetic ink paste 9) filling at least part of a cavity in the at least one outer material and wherein the at least one outer material in which the at least one identifying material fills at least part of the cavity is substantially opaque to visible light;

See *Office Action*, pp. 2-3. (Emphasis added).

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<sup>30</sup> The lettering of the clauses herein is merely for sake of clarity of argument and should not be taken to imply any particular ordering of the clauses.

Applicant respectfully points out that Wallace does not actually recite as suggested by the Patent Office. Rather, the portions of Wallace cited by the Patent Office recite as follows:

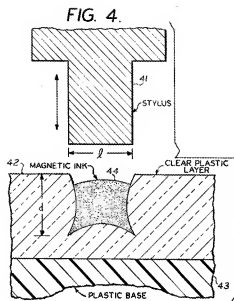


See Wallace, FIGs. 1 and 2

The stylus strikes the surface of the record member 3, leaving a line of indentations 7 spaced in an alpha-numeric code form. The presence of an indentation, for example, may represent the binary "1" signal and the absence, the binary "0" signal. The record member can usually be passed under the recording head at a rate of 1 to 50 inches per second. After being indented, the record member next has a magnetic ink paste 9 squeezed into the indentations, as by a blade 8. The surface of the card may then be wiped, if necessary, and the ink is allowed to cure.

See Wallace, col. 2, lines 41-53 (Emphasis added).





See Wallace, FIG. 4

A plastic card comprised of a plastic base layer 43 with a clear plastic top coating 42 is overcoated with a layer of a magnetic ink or paste (not shown) in the area to be indented, and the ink is partially pre-dried, if desired, to some extent. A blunt end stylus 41 is then used to indent the card in the manner previously described and force the ink 44 into the indentation.

See Wallace, col. 3, lines 41-47

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference...The identical invention must be shown in as complete detail as is contained in the...claim...The elements must be arranged as required by the claim..." MPEP § 2131 (emphasis added).

Applicant has reviewed the Patent Office-cited portions of Wallace (i.e. those portions which must support a case of unpatentability on their face) and, as can be seen from the foregoing, the Patent Office failed to provide any evidence to support its allegations that Wallace expressly teaches or suggests the all the claim features of Claim 43.

As noted, Claim 43 recites: "producing the item using the computer-readable representation of the item, the item including (1) at least one structural material,

and (2) the at least one three-dimensional configuration, the at least one three-dimensional configuration including...at least one identifying material substantially shaped as at least part of the at least one three-dimensional configuration and enclosed within the at least one structural material..." (Emphasis added)

In contrast, Wallace merely recites: "The stylus strikes the surface of the record member 3, leaving a line of indentations...and magnetic ink paste 9 [is] squeezed into the indentations" or that "[a] blunt end stylus...is then used to indent the card in the manner previously described and force the ink...into the indentation."

As can be seen from the directly quoted portions of Wallace and Applicant's claims, significant distinctions exist between the express recitations of Wallace and the Applicant's claims (e.g. Wallace's failure to expressly recite an "identifying material substantially shaped as at least part of the at least one three-dimensional configuration and enclosed within the at least one structural material")

As such, the burden rests on the Patent Office to provide an interpretation of Wallace and Claim 43 supported by objective evidence that "bridges the gap" between the actual recitations of Wallace and the actual recitations of Applicant's claims. In its attempt to account for those significant distinctions it appears to Applicant that the Patent Office has mapped the recitations "identifying material substantially shaped as at least part of the at least one three-dimensional configuration and enclosed within the at least one structural material" of Claim 43 onto "a line of indentations."

As can be seen from the directly quoted portions of the Patent Office rejection of Claim 43, the Patent Office has failed to provide objective evidence that demonstrates that "a line of indentations" of Wallace may be interpreted to teach or suggest "identifying material substantially shaped as at least part of the at least one three-dimensional configuration and enclosed within the at least one structural material" as in Claim 43. Particularly, Applicant respectfully submits that the Patent Office has not explained how it reaches such mappings under the broadest

reasonable interpretation framework<sup>31</sup> as is the Patent Office's burden (e.g., such as by examples drawn from Applicant's claims or detailed description). Applicant points out that although Claim 43 has been quoted in the present rejection, several claim terms have not been addressed<sup>32</sup> in the Patent Office's analysis (e.g. at least the recitations "three-dimensional configuration and enclosed within the at least one structural material").

What a reference "teaches" is a question of fact. Conclusory statements that a reference "teaches" something beyond its bare recitations/direct disclosures do not constitute ANY evidence of such "teachings" unless they are supported by objective evidence. See *In re McNeil-PPC*, 2008-1546 (Fed. Cir. July 31, 2009); *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

Thus, when a party to a matter asserts that a reference "teaches" something beyond its bare recitations/direct disclosure, and that factual assertion is challenged by an opposite party, the law requires that the asserting party provide objective evidentiary support to "close the gap" between what the reference actually recites and what the asserting party alleges the reference teaches. In the absence of such evidence, there should be no finding of fact in favor of the asserted teaching.

Because the Patent Office failed to establish that Wallace expressly teaches or suggests the recitations of Claim 43 and the Patent Office has failed to provide an interpretation of Wallace supported by objective evidence which properly maps these recitations to the recitations of Wallace, under MPEP guidelines the Patent Office has not established a *prima facie* case of the unpatentability of Claim 43. For these reasons, Applicant respectfully asks the USPTO to hold Claim 43 allowable and to issue a Notice of Allowability of same.

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<sup>31</sup> During patent examination, the Patent Office determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004).

<sup>32</sup> "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

**2. The Patent Office's Interpretation of Wallace Appears to be Based on Inadvertent Impermissible Hindsight, Personal Knowledge, or Official Notice**

Applicant respectfully points out that the Applicant's Application is the only objectively verifiable Patent Office-cited document of record that shows or suggests what the Patent Office purports the Wallace reference to teach. From this and the express recitations of Wallace as set forth above, it follows that the Patent Office may be interpreting Wallace through the lens of Applicant's application, which is impermissible hindsight use. If such is the case, at present, the Patent Office's assertions regarding Wallace are untenable.

Further, as the Patent Office has provided no objectively verifiable evidence, nor argument based on objectively verifiable evidence, in support of the Patent Office interpretation regarding what the technical material cited by the Patent Office "teaches," Applicant infers that the Patent Office may be relying on "personal knowledge" and/or is taking "official notice" of one or more factors to reach the factual conclusion of what the cited technical material "teaches" but has failed to expressly acknowledge as such in the written record.

In view of the foregoing, if the Patent Office desires to maintain the rejection, in the next communication, Applicant respectfully requests that the Patent Office provide an affidavit or declaration setting forth objectively verifiable evidence in support of the Patent Office's currently unsupported assertions regarding what the cited technical material "teaches" and/or should be interpreted to "teach." See, e.g., MPEP § 2144.03(C), *If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Patent Office Must Support the Finding with Adequate Evidence*, and 37 C.F.R. 1.104(d)(2).

Absent an affidavit setting forth such objectively verifiable evidence supporting the Patent Office's interpretation of Wallace, under MPEP standards, the Patent Office has not established a *prima facie* case that the Patent Office-cited references of record render Claim 43 *prima facie* unpatentable. Applicant

respectfully asks the Patent Office to hold Claim 43 allowable and to issue a Notice of Allowance of same.

**3. Claims 44-48 Patentable for at Least Reasons of Dependency from Claim 43**

Claims 44-48 depend either directly or indirectly from Claim 43. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." See 35 U.S.C. § 112 paragraph 4. Consequently, Claims 44-48 are patentable for at least the reasons why Claim 43 is patentable. Accordingly, Applicant respectfully requests that The Patent Office hold Claims 44-48 patentable for at least the foregoing reasons, and issue a Notice of Allowability on same.

#### IV. CONCLUSION

Applicant may have during the course of prosecution cancelled and/or amended one or more claims. Applicant notes that any such cancellations and/or amendments will have transpired (i) prior to issuance and (ii) in the context of the rules that govern claim interpretation during prosecution before the United States Patent and Trademark Office (USPTO). Applicant notes that the rules that govern claim interpretation during prosecution form a radically different context than the rules that govern claim interpretation subsequent to a patent issuing. Accordingly, Applicant respectfully submits that any cancellations and/or amendments during the course of prosecution should be held to be tangential to and/or unrelated to patentability in the event that such cancellations and/or amendments are viewed in a post-issuance context under post-issuance claim interpretation rules.

Insofar as that the Applicant may have during the course of prosecution cancelled/amended/argued claims sufficient to obtain a Notice of Allowability of all claims pending, Applicant may not have during the course of prosecution explicitly addressed all rejections and/or statements in The Patent Office's Office Action. The fact that rejections and/or statements during the course of prosecution may not be explicitly addressed should NOT be taken as an admission of any sort, and Applicant hereby reserves any and all rights to contest such rejections and/or statements at a later time. Specifically, no waiver (legal, factual, or otherwise), implicit or explicit, is hereby intended (e.g., with respect to any facts of which The Patent Office took Official Notice, and/or for which The Patent Office has supplied no objective showing, Applicant hereby contests those facts and requests express documentary proof of such facts at such time at which such facts may become relevant). For example, although not expressly set forth during the course of prosecution, Applicant continues to assert all points of (e.g. caused by, resulting from, responsive to, etc.) any previous Office Action, and no waiver (legal, factual, or otherwise), implicit or explicit, is hereby intended. Specifically, insofar as that Applicant does not consider the cancelled/unamended claims to be unpatentable,

Applicant hereby gives notice that it that it may intend to file and/or has filed a continuing application in order prosecute such unamended claims.

With respect to any cancelled claims, such cancelled claims were and continue to be a part of the original and/or present patent application(s). Applicant hereby reserves all rights to present any cancelled claim or claims for examination at a later time in this or another application. Applicant hereby gives public notice that any cancelled claims are still to be considered as present in all related patent application(s) (e.g. the original and/or present patent application) for all appropriate purposes (e.g., written description and/or enablement). Applicant does NOT intend to dedicate the subject matter of any cancelled claims to the public.

The Patent Office is encouraged to contact the undersigned by telephone at (402) 496-0300 to discuss the above and any other distinctions between the claims and the applied references, if desired. Also, if the Patent Office notes any informalities in the claims, he is encouraged to contact the undersigned to expediently correct such informalities.

Respectfully submitted,

Dated: February 24, 2010

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